

No. 16132

IN THE

# United States Court of Appeals

FOR THE NINTH CIRCUIT

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JAMES MOON, EDMOND M. WAGNER and PHILIP SUBKOW,  
*Appellants,*

*vs.*

CABOT SHOPS, INC., and HOWARD SUPPLY COMPANY,  
*Appellees.*

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## APPELLANTS' REPLY BRIEF

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**APPELLANTS' REPLY BRIEF**

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1. Appellees Have Avoided Answering the Appellants on Most of the Issues Raised by the Appeal.

In Appellants' Opening Brief at pages 47 and 48 we stated the questions upon whose answer it was believed the issue of infringement turned. We respectfully refer the Court to this statement.

The Appellees have ignored these issues and have based their support of the Court's judgement solely on a file wrapper estoppel. They have baldly asserted that claim 2 is not "literally infringed" by Appellees' drive-in units and have ignored all of the other claims on this issue. They have abandoned the District Court on the ground upon which the Court found no infringement. This ground is stated in the Court's Conclusion of Law that the prior art limits the range of equivalents to which the claims are

entitled and that the range of equivalents does not include the accused devices. Although the presence of a file wrapper estoppel was argued, the Court did not base its judgment of non-infringement on any file wrapper estoppel. It is also significant to note that Appellees have rested their case entirely on the effect of the file wrapper estoppel as applied to claim 1. They have said nothing as to whether or not claims 2-5 are also limited by the file wrapper so that Appellees' structure does not infringe. They lump claims 2-5 with claim 1 by innuendo.

**2. Appellees Have Made No Answer to Appellants' Contention That by Their Clear Language Claims 2-5 May Not Be Restricted to Only the Form Shown by Fig. 3 and 6 of the Patent.**

We have by detailed analysis of the claims shown that in claims 2-5 the word "straddle" in claims 2-4 refers to all four legs of the derrick. The word "straddle" in claims 2-4 refers to the front legs as well as the rear legs. Whatever the word means with respect to the rear legs it means the same thing with respect to the front legs. This can only mean that two legs are to one side and two legs are to the other side of the driver's position. This is certainly true of claim 5 which makes no reference to straddling.

Claim 1 does locate the driver's position which respect to the rear legs but this is done by stating that the driver's position enters the free space between the rear legs. It is this statement which locates the rear legs fore and aft of the chassis. We have discussed these points at pages 53-58 of Appellants' Opening Brief.

To construe the claims 2-5 to require that the driver's position enter the free area between the rear legs would impart to claims 2-5 the limitations of claim 1. Rules of

claim construction require that the limitations of one claim be not introduced into another claim which is itself not broader than the invention. We have discussed this point at pages 82-86 of Appellants' Opening Brief.

Further Appellees' position would restrict the claims to a particular form of the invention which was never, either in the specification or in the argument presented in the prosecution of the patent made to be an important criterion of the invention. The drawings are merely illustrative and nothing in the specification makes the particular location of the legs, such as is shown in the drawings of the patent, of any critical significance. The specification of the Patent Exhibit 1 Record Page 638 line 70 *et seq.* Column 4 states:

"While I have described a particular embodiment of my invention for the purpose of illustration, it should be understood that various modifications and adaptations thereof may be made within the spirit of the invention as set forth in the appended claims."

The claims 2-5 may therefore not be so restricted so that a modification within the spirit of the claimed invention is excluded from the claims.

We have discussed this part at pages 77-82 of the Appellants' Opening Brief.

3. **Except by Reference to Claim 2, the Appellees Have Made No Reply to the Appellants' Contention That Claims 2-5 Read on the Appellees' Drive-in Unit.**

The language of claims 2-5 is "literally infringed" by Appellees' structure. Appellees state that the language of claim 2 (no reference is made to claims 3-5) is not "literally infringed" and give as their reason that the hinge in



their construction is at the "extreme upper front corner of the truck" and that the derrick is all forward of the vehicle. (Appellees' Brief pp. 8 and 9.) Both the conclusion and the fact alleged in support thereof are incorrect.

Reference to Exhibit 59 [R. p. 773] and Exhibit 84 [R. p. 774], Exhibits 57, 95, 93, 94, 77, 81, 54, 62, 55, 60, 63, 65 reproduced in the Appendix to Appellants' Opening Brief and Exhibit C in the Appendix to Appellees' Brief will show that in all cases the hinge is behind the front end of the truck.

We have shown that the rear legs of the derrick in the Appellees' drive-in unit reach the ground through a pyramidal truss formed by the outrigger and the hinge supporting structure. This pyramidal truss embraces the cab and is to the immediate right and left of the driver. This structure is substantially the same as that formed by the hinge supporting frame work and the rear legs illustrated in Fig. 3 and 6 of the Patent Exhibit 1. We have discussed this point in Appellants' Opening Brief at pages 36-46 and 58-63.

It is significant to note that Mr. Woody, Chief Engineer of Appellees, Cabot Shop Inc., in describing the Appellees' structure used the word "straddle" to describe the transverse extent of the legs of Appellees' derrick [see R. pp. 594-595 quoted p. 37 of Appellants' Opening Brief].

The legs of Appellees' derrick functionally and structurally "straddles" the cab and driver position in the cab even if the word "straddle" is to be limited in the sense urged by Appellees.



**4. The Appellees Have Made No Contention That the Prior Art Limits the Claims to a Particular Construction Which They Do Not Employ.**

They have abandoned the District Court on this ground. We have made a thorough analysis of the prior art in evidence on this point in pages 64-75 of Appellants' Opening Brief and have shown that none of the prior art describes any portable telescopic four legged derrick hinged in any way at the front of the chassis above the driver's position. The Court was clearly wrong in its conclusion of law on which it based its judgement of non-infringement.

**5. Appellees Pass by the Issue as to Whether the Differences Which They Urge to Exist Between the Claims and the Appellees' Structure Are Merely Colorable Differences.**

Appellees answer by saying that the file wrapper limits the claims so that because of the alleged differences the Appellees' drive-in units are not an infringement of the claim. They thus urge that while the Appellees' drive-in units produce the same results in substantially the same way, the form of the device employed by the Appellees is not of the form of the device to which the file wrapper limited the claims. In this they are wrong.

**6. Appellees Admit That the Claim 2 Is Unambiguous and Have Not Pointed to Any Ambiguity in Any of the Other Claims.**

(Appellees' Brief pp. 8 and 9)

Where the claims are unambiguous the issue of infringement turns on whether the claims "read" on the Appellees' drive-in unit and whether, if they do not "read" on the Appellees' drive-in unit, they are the equivalent thereof.

Not having shown any ambiguity in the claims, Appellees have not made out a case requiring resort to the file wrapper history.

The Supreme Court in *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 70 S. Ct. 854 at 855-856; 339 U. S. 605, 94 L. Ed. 1097; 85 U.S.P.Q. 328 at p. 330, stated the rule as follows:

“In determining whether an accused device or composition infringes a valid patent, resort must be had in the first instance to the words of the claim. If accused matter falls clearly within the claim, infringement is made out and that is the end of it.”

Recourse to the file wrapper would not be necessary since there is nothing to construe.

In *Research Products Co. v. Tretolite* (9th C.C.A. 1939), 106 Fed. 530 pp. 535-536. This Court, in passing on the argument that the withdrawal of a claim limited other claims, stated,

“In any event its withdrawal did not affect the plain terms of the claims allowed. Such withdrawal would only be important where the allowed claims were ambiguous”.

Quoted at page 15a of the Appendix to Appellants' Opening Brief. See also other cases cited at page 87 of Appellants' Opening Brief.

**7. The Contention That the File Wrapper Limited All the Claims to the Form of the Portable Derrick Recited in Claim 1 is Fallacious.**

Appellees have urged the point that claim 1 is limited to the structure in which the driver's position enters the free area between the rear legs in a manner similar to the specific form of the structure as illustrated in the drawings

of the Patent. They then, without further showing, lump all the claims together into their statement that the file wrapper limits the claims so that they are not infringed unless their language is expanded to include the territory yielded by the Applicant. (Appellees' Brief p. 8.)

Appellees have referred to and printed in their Appendix only fragments of the file wrapper. The entire file wrapper has been incorporated into the record as a physical exhibit by stipulation between the parties dated September 5, 1958. We have made a detailed analysis of the file wrapper at pages 86 to 96 of the Appellants' Opening Brief.

It is clear from the history of the prosecution that the Appellant refused to limit all his claims so as to say that only the rear legs and not the front legs straddle the cab. He refused to limit claims 2-4 to any meaning of "straddle" to be that only the rear legs "straddle" the driver's position by offering and insisting on claims in which the term "straddle" referred to all of the legs. The Examiner again rejected these claims but not because the claims were unpatentable over the prior art but because of informality in the claims. These informalities were corrected in a manner which made no change in their substance. Claim 22 (claim 5 of the Patent) was presented.

The allowance of all claims followed without any further amendment of claims 1-4 or amendment of claim 5.

Claim 5 as well as claims 2-4 of the Patent are broader than claim 1 of the Patent. The Examiner simply changed his mind and allowed claim 18 (claim 1 of the Patent) and all of the other claims of the Patent. These broader claims thus may not be restricted to be of the same scope of claim 1. (We have discussed this point at pages 94-97 of Appellants' Opening Brief.)

8. Appellees' Argument That the Appellants Are Attempting to Expand the Area of the Allowed Claims to Be That of the Claims as Originally Presented Is Contrary to the Evidence.

In support of their argument they contrast claim 1 as originally presented in the specification as filed with claim 1 of the Patent. (Appellees' Brief pp. 4 and 5.) A comparison of the two claims will indicate other differences than the features printed in red on page 5 of the Appellees' Brief.

We have reproduced below claim 5 of the patent as given in outline form in Exhibit 1A Record pages 655-656. In claim 5 we have placed in italics the portions of claim 5 which are different from claim 1 as presented in the Application as filed:

*Claim 5:*

A portable derrick, comprising

A. a chassis,

B. Front wheels mounted on an axle positioned adjacent the front end of the chassis,

C. Rear wheels mounted on an axle positioned adjacent the rear end of the chassis,

D. A driver's position with steering and motive power controls positioned adjacent the front end of said chassis,

E. *A motive power unit positioned at the rear of said chassis,*

F. *A collapsible and extensible derrick pivotally mounted on the chassis to move from a rest position on said chassis with the top end of the derrick positioned toward the rear of said chassis and the lower end of*

*said derrick being positioned on said chassis toward the front end of said chassis,*

*(a) spaced two front and two rear legs for said derrick, cross bracing between said legs,*

*(b) said derrick comprising a lower section and an upper section,*

*G. Means for moving said upper section relative to said lower section to collapse and to extend said derrick,*

*H. a hinge on said derrick positioned adjacent the lower end of said derrick,*

*(a) said hinge also positioned on said chassis adjacent the front axle and above said driver's position,*

*I. means for rotating said derrick to an erect position adjacent the front end of said chassis, and*

*J. means cooperating with the lower ends of said derrick legs to place said legs in load transference relation to the ground with said derrick in erect position;*

*(a) said lower ends of said legs and said means cooperating therewith*

*(1) being spaced apart transversely with respect to said chassis a distance greater than the transverse extent of said driver's position; and*

*(2) said lower ends, said means cooperating therewith, and said hinge being*

*a. located with respect to the longitudinal axis of said chassis*

*1. locating said lower ends of one pair of front and rear legs and their respective cooperating means*

*a. to one side of said driver's position and*

*b. the lower ends of the other pair of front and rear legs and their respective cooperating means to the other side of said driver's position*

*c. with the derrick in said erect position.*



We summarize below the features of the original claims 1-5 relating to the derrick and its hinging as presented in the original specifications with the corresponding features of the claims of the Patent. It is clear that the derrick and its hinging in Appellees' structure is within the ambit of the matter specifically included in the claims of the Patent. The derrick and its hinging in Appellees' Drive-in units are not within the area of the matter relating to the derrick and its hinging broadly included in the original claims but not specifically included in the allowed claims.

a) *The Derrick*

The original claims included a derrick without specifying the kind of derrick except that it had legs. This may be a two legged pole type-derrick such as was used in prior art. [See Finding of Fact R. p. 88 incorporating PreTrial Order items 12 R. p. 60 including Plaintiff's Statement of Fact Item 8 R. p. 30.] The claims in the Patent specify a four legged lattice type telescopic derrick whose lower leg portions are spread apart transversely for a distance greater than the transverse extent of the driver's position. [See item J of claims 1-3 and 5 and item L claim 4 R. pp. 648-656.] Such a derrick is employed by Appellees.

b) *The location of the hinge on the derrick.*

The original claims did not locate the position of the hinge on the derrick. The claims of the Patent state that it is at the lower end of the derrick where it is located on the Appellees' structure.

c) *The location of the hinge with respect to the driver's position.*

In the original claims 1-5 the position of the hinge is not given with reference to the driver's position. The derrick could be hinged below or to one side of

the driver's position. The claims of the Patent specify that the hinge is above the driver's position as it is in the Appellees' construction.

No estoppel exists to limit the location of the hinge with respect to the fore and aft axis of the chassis. The statement that the hinge is above the driver's position does not mean that it must be vertically over the driver. It merely means that the hinge is at a higher elevation than the driver's position and that is what it means in the specification. (See Appellants' Opening Brief pp. 53-57.) The location of the hinge and the position of the legs are described by the Patent in connection with their location at the front end of the chassis and their spread transversely to permit the driver to have a clear view ahead. (See Appellants' Opening Brief pp. 55-67.) The hinge and derrick legs in Appellees' drive-in unit are located in the same way.

**9. The Appellees' Structure Is Clearly Included in the Words of the Claims and Is the Equivalent of the Structure Illustrated in the Drawings of the Patent.**

No recourse to any file wrapper estoppel can obscure the fact that Appellees have appropriated the very heart of the patented invention. The simple truth of the matter is that the distinctions in form between Appellees' construction and the illustrations in the drawings of the Patent make no change in the results produced, the way the results are produced or the means by which they are produced.

That Appellees' drive-in units are clearly equivalents of the form illustrated in the drawings of the Patent is admitted by the Appellees. That which is equivalent in the



patent law is the same thing in the eyes of the patent law. Even if there were file wrapper estoppel to limit the claims to the form of the structure shown in the drawing, Appellees' structure would infringe because of this equivalence. The Appellees seek to avoid the operation of the doctrine of equivalents by reliance on an asserted file wrapper estoppel as limiting the operation of the doctrine of equivalents. The argument is specious. The rule is otherwise. The doctrine of equivalents is a limitation on the operation of any file wrapper estoppel. (See Appellants' Opening Brief p. 96.)

In *Cutter Laboratories v. Lyophile-Chryochem Corp.* (9th C.C.A. 1949), 179 F.2d 80 at p. 89, this Court said,

"Appellant invokes the doctrine of *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274, 24 L.Ed. 344, that no limitation which a patentee puts into his claim may be ignored, whether or not the limitation was necessary to validate the claim. See, also, *Fay v. Cordesman*, 109 U.S. 408, 3 S.Ct. 236, 27 L.Ed. 979. One reason for this rule is to give notice to possible infringers of the claim's limits; another is to relieve the courts of the burden of deciding just what elements are material to the validity of the claim. But where attempts are made to avoid infringement by a relatively slight, well known variation in the claimed process or product, the strict rule is relaxed by the doctrine of equivalents. 'Without that doctrine every claim is indeed entitled to be interpreted in the light of the specifications as a whole, and not to be read merely with a dictionary. But often even with the most sympathetic interpretation the claim cannot be made to cover an infringement which in fact steals the very heart of the invention: no matter how auspiciously construed, the language forbids. It is then

that the doctrine of equivalents intervenes to disregard the theory that the claim measures the monopoly and ignores the claim in order to protect the real invention. *Claude Neon Lights v. Machlet & Son*, 2 Cir. 36 F.2d 574; see also *Otis Elevator Co. v. Atlantic Elevator Co.*, 2 Cir., 47 F.2d 545, 547; *Oates v. Camp*, 4 Cir., 83 F.2d 111, 116.' *Keith v. Charles E. Hires Co.*, 2 Cir., 116 F.2d 46, 48" (p. 89). \* \* \*

**10. Appellees Have Made No Showing That Their Drive-in Unit Conforms to the Prior Art Cited by the Examiner and Consequently the File Wrapper Can Be of No Avail to Them.**

Appellees have not shown that their drive-in unit is within the area of the prior art cited by the Examiner. No drive-in unit is shown in such prior art. In such case Appellees cannot be aided by any file wrapper estoppel.

In *Hunt Tool Company v. Lawrence* (5th C.C.A. 1957), 242 F. 2d 347 at p. 354 the Court said,

"Also, since the patent examiner's objection was with reference to the prior art, appellants are protected by file wrapper estoppel only if they can show that their alleged infringement is in an area to which that prior art could possibly have been thought to extend so as to make it impossible to make valid claims there, for there is no reason to presume that applicant made a disclaimer broader than necessary to yield to the actual challenge to his claim. See *New York Scaffolding v. Whitney*, 8 Cir., 224 F. 452, 462, certiorari denied, 239 U.S. 640, 36 S. Ct. 161, 60 L.Ed. 482" (p. 354).

This is certainly so when the alleged limitation is to a feature which is not made a material part of the invention either in the Patent or by the evidence. We have at pages

94 and 95 of the Appellants' Opening Brief analyzed and quoted the opinion of this Court in *Union Oil Company of California v. American Bitumuls Co.* (9th C.C.A. 1940), 109 F. 2d 140 at pp. 145-46.

The Court there considered the effect of a temperature limitation inserted in a claim and introduced to replace a previous claim in which no specific temperature was stated. And we quote again from this opinion:

"We see nothing in the occurrences in the Patent Office which would estop the claimant from a reasonable interpretation of his patent claims as to temperature regardless of the specific temperature mentioned in the claims which is nowhere indicated either in the patent or by the evidence to have been a critical temperature." (pp. 145-146)

Appellees have cited *D & H Electric Company v. M. Stephens Mfg. Co.* (9th C.C.A. 1956) 233 F. 2d 879, as supporting their position on the issue of file wrapper estoppel.

In *D & H Electric Company v. M. Stephens Mfg. Co.* the Court found that the novel feature of the right angular orientation of the ribs was a feature which distinguished the patentees' invention from the prior art and resulted in an entirely different function. The Court said:

"It is immediately apparent that since, as urged by the inventor, the ribs of the patent article in suit perform the function entirely different from that of screw threads, the right angularity of the ribs is critical since to allow even a slight variation would lose the principle claimed for it by causing the ribs to become mere convolutions of a screw thread." (p. 883)

The Court acknowledged that the Appellees had made but a slight change in the angle of the rib. It said,

“\* \* \* Slight as this difference may seem it invokes an entirely different principle of operation. By reason of their right angularity, the ribs of appellants’ device are not and cannot be considered screw threads, while the projections of appellees’ device can be nothing other than interrupted screw threads.” (p. 884)

The factual situation is entirely different in the present case. The change made by Appellees in this case made no change in the principle of the invention and did not make the Appellees’ drive-in unit like the prior art. At no time was it urged by the Applicant in the Patent Office that the location of the rear legs as shown in Fig. 3 of the patent was the critical difference between the Applicant’s device and the prior art.

The case cited by Appellees does not impair the force of *Union Oil Co. of California v. American Bitumuls Co. supra* or *Cutter Laboratories v. Lyophile-Chryochem Corp. supra*. It illustrates the same principle. The present appeal illustrates the principle announced in *Winans v. Denmead*, 15 Howard (56 U.S.) 330.

The patent before the Court was a railroad coal car having a conical discharge chute of circular cross-section. The defendant’s chute had an octagonal cross-section. (pp. 339-340)

In discussing the lower Court’s ruling the Supreme Court said:

“The substance of this ruling was that the claim was limited to the particular geometric form mentioned in the specification; and as the defendants had not made cars in that particular form there could be

no infringement, even if the cars made by the defendants attained the same result by employing what was in fact, the same mode of operation as that described by the patentee. We think the ruling was erroneous." (p. 340)

\* \* \* \* \*

"Now, while it is undoubtedly true that the patentee may so restrict his claim as to cover less than what he invented, or may limit it to one particular form of machine, excluding all other forms, though they so embody his invention, yet such interpretation should not be put upon his claim if it can fairly be construed otherwise, and this for two reasons:

"1. Because the reasonable presumption is, that, having a just right to cover and protect his whole invention, he intended to do so. *Haworth v. Hardcastle*, Web. P.C.484.

"2. Because specifications are to be liberally construed in accordance with the design of the Constitution and the patent laws of the United States, to promote the progress of the useful arts and allow inventors to retain to their own use, not anything which is matter of common right, but what they themselves have created. (citing cases)" (p. 341)

\* \* \* \* \*

"Undoubtedly there may be cases in which the letters patent do include only the particular form described and claimed, \* \* \*

"The reason why such patent covers only one geometrical form is not that the patentee has described and claimed that form only; it is because that form only is capable of embodying his invention; and consequently, if the form is not copied, the invention is not used." (p. 343)



11. To Allow Appellees to Escape the Charge of Infringement by Such an Immaterial Change in Construction Would Be to Validate the Patent but to Emasculate It by Removing Its Substance.

In *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, *supra*, at 70 S. Ct. at pp. 855-856 and 85 U.S.P.Q. at p. 330, the Court stated:

"But courts have also recognized that to permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing. Such a limitation would leave room for — indeed encourage — the unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law. One who seeks to pirate an invention, like one who seeks to pirate a copyrighted book or play, may be expected to introduce minor variations to conceal and shelter the piracy. Outright and forthright duplication is a dull and very rare type of infringement. To prohibit no other would place the inventor at the mercy of verbalism and would be subordinating substance to form. It would deprive him of the benefit of his invention and would foster concealment rather than disclosure of inventions, which is one of the primary purposes of the patent system."

"The doctrine of equivalents evolved in response to this experience. The essence of the doctrine is that one may not practise a fraud on a patent. Originating almost a century ago in the case of *Winans v. Denmead*, 15 How. 330, it has been consistently applied by this Court and the lower federal courts, and con-

tinues today ready and available for utilization when the proper circumstances for its application arise.

\* \* \*

### Conclusion.

The Appellees who have abandoned the Court below on the ground upon which it found no infringement have based their entire position on an asserted file wrapper estoppel.

The Court below upon whom such a contention was urged, did not find any file wrapper estoppel. We submit that no reason is presented by the facts of the case or by argument by Appellees which requires that the claims be so narrowly construed as to limit them to the form of the device shown in Fig. 3 of the Patent. We submit that the claims 2-5 read unambiguously on Appellees' device. No basis for resort to file wrapper for interpretation of the claims appears in this case. But reference to the file wrapper will show that no file wrapper estoppel appears which will require the claims to be limited to the specific form illustrated in Fig. 3. But even if this be so, the Appellees infringe since they have, in the language approved by this Court, "stolen the heart of the invention."

We submit that this Court should hold that the judgment of non-infringement is clearly wrong and that Appellees infringe the claims of the patent in suit.

Respectfully submitted,

PHILIP SUBKOW,

*In Propria Persona and Attorney for  
Appellants.*